

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court for the Eastern District of New York, reported in 30 Fed. Sup. 448, appears at pages 545-564 of the Record. The opinion of the Circuit Court of Appeals for the Second Circuit, reported in 46 U. S. P. Q. 294, appears at pages 574-8 of the Record.

Jurisdiction.

The decision of the court below was rendered on July 15, 1940; the judgment was entered July 1, 1940; and a Petition for Rehearing was denied on July 31, 1940. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925; U. S. C. Title 28, Section 347 (a).

Statement of the Case.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ, as well as a statement of the questions involved in the case.

Specifications of Error.

The Circuit Court of Appeals for the Second Circuit erred:

(1) in reversing and not affirming the decree of the United States District Court for the Eastern District of New York which held the patent in suit valid and infringed and ordered an accounting and the issuance of an injunction;

(2) in holding that the burden is upon petitioner to prove utility of the patented structure;

(3) in not holding that the burden is upon respondent to prove lack of utility of the patented structure; and

(4) in not holding that the respondent, a confessed infringer, was estopped to deny utility.

Argument.

The Circuit Court of Appeals admitted (R. 576, 46 U. S. P. Q. 295) that none of the prior art "had ever prescribed such a relation, and we could hardly hold that the art had actually anticipated it", in speaking of the relationship between the bearings and the variable horizontal plane of the center of gravity of the basket. It then said that none of the seven original claims specifically claimed the relationship and that the specific patent claim was only put in after rejection on prior art. This, said the Circuit Court of Appeals, persuaded it that there was no substance in the detail at all. In holding that plaintiff was not able to verify the utility of the patented structure, the court placed the burden of proof upon respondent in spite of the fact that the court admitted that the patented structure did produce good results. Then it held that without such verification the differences over the prior art were of no "proved value" and therefore insufficient to support a patent.

The court was not justified in assuming that the differences were of no substance. They were broadly claimed in the original claims and the original specification fully set forth the construction and the advantages that flowed therefrom.

Original claim 7 (R. 514) recited the combination more broadly than does the patent claim and recited the relationship which produces the "good result" broadly as "a support for said casing constructed to permit easy lateral vibrations of the casing". It is quite usual in the original patent application broadly to claim the combination and

then specifically revise the claims in view of the art. This has been held to be perfectly proper in a situation similar to that in the instant cause by this Honorable Court in *De La Vergne v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 288, in which Mr. Chief Justice Fuller said:

“In the case at bar there was not only no amplification of the original application by the amendment, but it was within the scope of the original specification, and a limitation and narrowing of the original claim, so that it was the identical invention sworn to by Boyle; and there was no more reason for requiring a new oath from his administratrix than there would have been for requiring it from Boyle himself.”

The court was not justified in ruling, in the absence of evidence, that there was no utility in the claimed invention because the burden was upon respondent to prove lack of utility, and certainly it was not justified in so holding as the infringing machine is admittedly a copy of the commercially successful machine of respondent, which machine was, as held by the Circuit Court of Appeals, within the scope of the patent in suit (R. 578, 46 U. S. P. Q. 296). Nor was it justified in so holding because, having held that the patented combination does produce “good results”, it was bound to hold that the prior art, which the court admitted fails to disclose the combination, does not negative invention in the combination of the claim sued upon.

Conclusion.

It is respectfully submitted that the Petition for Writ of Certiorari should be granted as prayed for.

Respectfully,

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